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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,950	02/12/2004	Tommy Rodrigues	FDN-2797	7092

Attn: William J. Davis, Esq.
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07/21/2008

EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

07/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,950

Applicant(s)

RODRIGUES ET AL.

Examiner

William V. Gilbert

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11, 16, 17, 19, 21-33, 36-51 and 53 is/are pending in the application.
- 4a) Of the above claim(s) 2, 6, 7, 32, 33 and 36-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-11, 16, 17, 19, 21-31, 50, 51 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a Final Office Action. Claims 1-3, 6-11, 16, 17, 19, 21-33, 36-51 and new claim 53 are pending. Claims 4, 5, 12-15, 18, 20, 34, 35 and 52 are cancelled. Claims 2, 6, 7, 32, 33 and 36-49 are withdrawn from consideration. Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50, 51 and 53 are examined.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51 are rejected under 35 U.S.C. 103(a) as being anticipated by Bondoc et al. (U.S. Patent No. 6,105,329), in view of Stahl (U.S. Patent No. 6,305,138) and Elliott (U.S. Patent No. 6,421,976).

Regarding Claims 1, Bondoc discloses a shingle (Figure 5, generally) with an anterior layer (1) and a posterior layer (15), the anterior layer having a head lap (Figure 1, element 3)

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and a butt (Figure 1, element 4), an alignment notch (Figure 1, element 6), the shingle having outermost bottom left and right corners, and at least one of the bottom outermost corners (element "A" from attached Figure 5 from Bondoc, below) corresponds to the alignment notch, the anterior tab has granules of a first shade and the posterior tabs have a second shade (Abstract, lines 1-2 and 20-21; Column 4, lines 52-64). The phrase "corresponds to the alignment notch" provides no further structural limitation as to how the corner and notch relate. The definition of *correspond* is "to be consistent, compatible or harmonious" (*Webster's II Dictionary*, third edition: Houghton Mifflin, 2005.) By using this definition and the broadest reasonable interpretation, the bottom outermost corner(s) correspond with the notch in that they are compatible with each other.

Bondoc does not disclose the limitations of the shadow band as claimed. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs, and Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott and Stall with the shingle in Bondoc because the shadings are aesthetic and provide

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no structural limitation to the claimed invention. Further, to have the shadow band a third shade would be obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice because matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See M.P.E.P. §2144.04(I) citing *In re Seid*, 161 F.2d 229 (CCPA 1947).

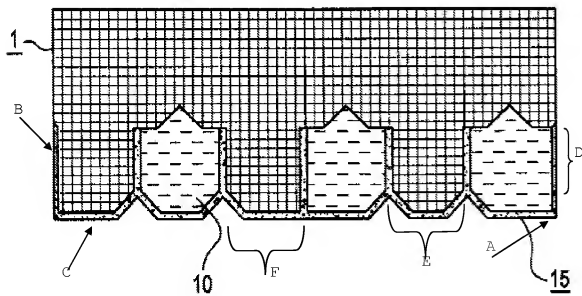


Figure 5 from Bondoc

Regarding Claim 3, the notch (6) has a triangle shape and a corner corresponds to a side of the triangle (element "A" from attached Figure 5 from Bondoc, above) and rejection of claim 1 for clarification of "corresponds".

Regarding Claims 8 and 29, Bondoc discloses a shingle with at least one layer (per Claim 29), a posterior layer (15) with a head lap (element "B" from attached Figure 5 from Bondoc, above) and tabs (element "C" from attached Figure 5 from Bondoc, above), an anterior layer positioned on the posterior layer (1), an anterior head lap (Figure 1, element 3), an alignment notch (Figure 1, element 6) and at least one anterior tab (Figure 1, element 2) positioned on the posterior tabs, and the anterior layer and posterior layer form a shingle, the shingle has outermost bottom left and right corners, and at least one of the outermost corners that corresponds to the alignment notch (see "A" above: see rejection of Claim 1 above for argument addressing *corresponds*), the anterior tab has granules of a first shade and the posterior tabs have a second shade (Abstract, lines 1-2 and 20-21; Column 4, lines 52-64). The phrases "formed from...length", per Claim 29, line 1, are statements of the process of making the claimed invention and must result in a structural difference between the claimed

invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim.

Bondoc does not disclose the limitations of the shadow band as claimed. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs, and Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott and Stahl with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention. Further, to have the shadow band a third shade would be obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice because matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See M.P.E.P. §2144.04(I) citing *In re Seid*, 161 F.2d 229 (CCPA 1947).

Regarding Claim 9, the alignment notch (Bondoc: 6) is triangular shape.

Regarding Claim 10, there are four posterior tabs (see Bondoc Figure 4, area proximate element 20).

Regarding Claim 11, the anterior and posterior tabs have first and second breadths respectively, and the second breadth is greater than the first breadth (see Figure 5 generally).

Regarding Claim 16, the posterior tabs (element C above) extend beyond the anterior tab (2; see Figure 5, generally).

Regarding Claims 17, 19 and 21 the anterior head lap (Figure 9, area proximate element 40, per Claims 17, 19, 21) extends beyond the posterior head lap (Figure 9, area proximate element 44, per Claim 17) the anterior head lap edge aligns to a posterior head lap edge (Figure 9, element 48, see area proximate element 42 where dotted line represents how the two headlaps may align, per Claim 19) and the posterior head lap extends beyond the anterior head lap (element "D" from attached Figure 5 from Bondoc, above, where the posterior head lap extends beyond the anterior headlap, per Claim 21).

Regarding Claims 22 and 23, Bondoc discloses two anterior tabs (Figure 8, element 60 per Claim 22) and three anterior tabs (Figure 8, element 60 per Claim 23).

Regarding Claim 24, Bondoc discloses the claimed invention except the spacing of the posterior tabs. It would have been obvious at the time the invention was made to a person having

ordinary skill in the art as a matter of design choice to make the shingle in Bondoc with these dimensions because Applicant failed to state a criticality for this spacing and the shingle in Bondoc is capable of being made in such a manner. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding Claim 25, the anterior tab (2) has a corner that corresponds to the alignment notch (see area proximate element A from attached Figure 5 above).

Regarding Claim 26, the posterior tabs (element "C" from attached Figure 5 from Bondoc, above) have corners (area proximate "A" above) that correspond to the alignment notch (6).

Regarding Claim 27, the anterior tab is positioned substantially centered on the posterior tab (element "E" from attached Figure 5 from Bondoc, above).

Regarding Claim 28, the anterior tab is positioned offset from the posterior tab (element "F" from attached Figure 5 from Bondoc, above).

Regarding Claim 30, the shingle has an anterior layer (1) and a posterior layer (15).

Regarding Claim 31, the phrase "formed from...length" per line 1 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim. Further, It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding Claim 50, Bondoc does not disclose a method of installing a shingle by affixing a shingle to the roofing area,

affixing another course to the roof by aligning the cut corner of one course with the alignment notch of the previous course, and repeating the above steps until the roof is completely covered. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to install the shingle in Bondoc in this manner because the shingle in Bondoc has the alignment notch (6) and the shingle has outermost bottom left and right corners and the corner corresponds to the notch (see rejection of Claim 1 above for clarification), and the edge corner and alignment notch correspond to act as an alignment means.

Regarding Claim 51, only the method of installing the shingle is claimed. The phrase, "formed from...length" line 2 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in the claimed manner, then it meets the claim.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc.

Regarding Claim 53, Bondoc discloses a roofing material comprising two roofing shingles each having an anterior layer and a posterior layer (1 and 15, respectively) that are of a substantially equal length (as shown in Fig. 5). The applicant should respectfully note that only the roofing material is claimed. The limitations provided in lines 3-11 are drawn to a method of making the shingle, including the cutting cylinder. These limitations are considered a product-by-process and determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985).

Bondoc does not disclose a plurality of the shingles as claimed, however, it would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04.

Response to Arguments

2. The following addresses applicant's remarks/arguments dated 21 April 2008:

Claim objections:

Applicant's amendments to the claims overcome the objection and it is withdrawn.

Claim rejections under 35 USC 102(b):

Applicant's amendments to the claims overcome the rejection and they are withdrawn; however, see newly cited rejection above.

Claim rejections under 35 USC 103:

Regarding applicant's arguments about the "shadow band" with the granules of a different shade, the examiner incorporated references (cited above) to make an obviousness rejection, and maintains the position that these features are purely aesthetic and are not a patentable feature (see rejection above.) Further, the examiner noted that applicant disagrees with the examiner's position of the "spacing of the posterior tabs" per claim 24, however, applicant respectfully provided no argument as to why there is disagreement, so the examiner

maintained his position regarding the rationale of the rejection (see above.) The examiner further wishes to emphasize his interpretation of the limitation "corresponds to" with relation to the "outermost bottom...corner" and the "alignment notch". The position is provided in the rejection above.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sieling (U.S. Patent No. 6,058,670); Hannah (U.S. D375,563); Hannah (U.S. D336,647).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635

/Basil Katcheves/

Primary Examiner, Art Unit 3635